

Docket No. 59216.1540
U.S. Patent Application Serial No. 10/532,833



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
KITAMURA, Toshio *et al.* :
U.S. Appln. Serial No.: 10/532,833 :
Filed: April 26, 2005 :

For: AN AUTOMATIC SHIFTING-OPERATION CONTROL SYSTEM

**PETITION TO CORRECT APPLICATION
CLASSIFICATION UNDER 37 C.F.R. 1.182**

Commissioner for Patents
P.O. Box DAC
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.182, Applicants respectfully petition the Director to reclassify the filing of United States Application No. 10/532,833 filed on April 26, 2005. Applicants inadvertently filed the application under 35 U.S.C. § 371. Applicants hereby petition to reclassify the filing to a United States national application filed under 35 U.S.C. 111(a). It is noted that this application claims the benefit of International Application No. PCT/JP2003/013653 filed October 24, 2003.

Applicants respectfully note that a similar Petition for U.S. Application Serial No. 10/529,703, "the '703 Petition" was submitted May 3, 2005. This subsequent Petition has since been accepted and granted. Enclosed is a copy of the Decision on Petition under 37CFR 1.182, for your records. For at least the reasons stated in the granted '703 Petition. Applicant respectfully assert that the present Petition is allowable as well.

Docket No. 59216.1540
U.S. Patent Application Serial No. 10/532,833

A copy of the Transmittal Letter and stamp dated receipt post card is attached for your reference. Upon granting of this petition it is requested that the file be forwarded to Certificate of Correction Branch for issuance of a Certificate of Correction.

Applicant hereby declares that, the Commissioner is hereby authorized to charge the total costs for the filing of this Petition to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59216.1540.

Respectfully submitted,

BAKER & HOSTETLER LLP

 44,588

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Date: August 4, 2005



23 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 4 2005

PATENT & TRADEMARK OFFICE

BAKER & HOSTETLER, LLP
WASHINGTON SQUARE, SUITE 1100
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WASHINGTON, DC 20036

In re Application of
KITAMURA et al.
Application No.: 10/529,703
PCT No.: PCT/JP03/12551
Int. Filing Date: 30 September 2003
Priority Date: 30 September 2002
Attorney's Docket No.: 59216.1500
For: APPARATUS FOR AND METHOD OF
CONTROLLING AUTOMATIC TRANSMISSION:

DECISION ON
PETITION
UNDER 37 CFR 1.182

This is in response to applicant's "Petition to Correct Application Classification under 37 CFR 1.182", filed in the United States Patent and Trademark Office (USPTO) on 03 May 2005. Applicant requests that the above referenced application be converted from a national application filed under 35 U.S.C. 371 to an application filed under U.S.C. 111(a). A \$400.00 petition fee has been charged to applicant's deposit account per their authorization.

BACKGROUND

On 30 September 2003, applicant filed international application PCT/JP03/12551, which claimed priority of an earlier Japanese application filed 30 September 2002.

On 29 March 2005, applicant filed a transmittal letter requesting filing under 35 U.S.C. 371 in the United States which was accompanied by, *inter alia*, the basic national fee of \$300.

On 03 May 2005, applicants filed the instant petition to convert the national stage application, mistakenly filed under 35 U.S.C. 371, to an application filed under 35 U.S.C. 111(a).

DISCUSSION

Applicant submitted U.S. national application papers including an amended specification indicating the following : "This application is a continuation of PCT/JP03/12551 filed on September 30, 2003."

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a

regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The Transmittal Letter (Form PTO-1390) filed on 29 March 2005 identified the application as "a filing under 35 U.S.C. 371." The specification, filed on the same date, in the first line identifies the papers as a "continuation of PCT/JP03/12551 filed on September 30, 2003." The Transmittal Letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. The Office provides the TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 (FORM PTO-1390) so that applicants can comply with 37 CFR 1.495(g) and so that the Office's personnel can readily distinguish between submissions under 35 U.S.C. 371 and 35 U.S.C. 111(a). Applicants submitted the papers with the Transmittal Letter indicating that applicants were filing under 35 U.S.C. 371. The filing of the PTO-1390 is viewed by office personnel as a clear indication of papers submitted under 35 U.S.C. 371.

Nevertheless, applicants' reference to the papers as a continuation application in the specification is inconsistent with the Transmittal Letter filed 29 March 2005 and contradicts the request in the Transmittal Letter to file under 35 U.S.C. 371. A national application which requests treatment as a continuation of an earlier international application cannot be considered the national stage application of that international application, and under the present circumstances, the statement in the specification is an indication of papers filed under 35 U.S.C. 111(a).

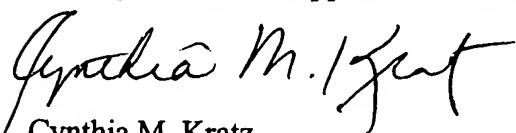
In view of the above, it is proper to grant applicants' petition to treat the initial filing as a filing under 35 U.S.C. 111(a). The declaration filed on 29 March 2005 and the specification filed on 29 March 2005 met the requirements for granting a filing date for a filing under 35 U.S.C. 111(a). Accordingly, the petition to accept the papers as a filing under 35 U.S.C. 111(a) with an filing date of 29 March 2005 is **GRANTED**.

Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/529,703) and the international application (PCT/JP03/02551) designating the United States were copending on 29 March 2005.

CONCLUSION

The petition under 37 CFR 1.182 to consider the papers filed on 29 March 2005 as a U.S. application filed under 35 U.S.C. 111(a) is **GRANTED**.

This application is being forwarded to the International Division for removal of the papers communicated from the International Bureau to the United States of America. The application will then be forwarded to Office of Initial Patent Examination (OIPE) for processing as a regular national application under 35 U.S.C. 111(a) with a filing date of 29 March 2005.



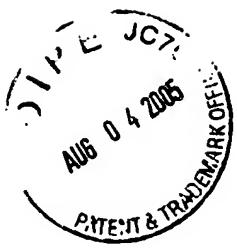
Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Application No.: 10/529,703

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Office of PCT Legal Administration

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EARLY SERIAL NUMBER POSTCARD
BOX PCT

The Patent Office acknowledges, and has stamped hereon, the date of receipt of the items checked:
Docket: 59216.1540

Applicant(s): Toshio KITAMURA et. al

Application No.: New U.S. National Phase Patent Application under 35 U.S.C.371

Title: AN AUTOMATIC SHIFTING-OPERATION CONTROL
SYSTEM

Filed: Herewith **Group Art Unit:** N/A **Batch No.:** N/A

Application : 2 sheets 2 Certified copies of JP priority applns.
Transmittal

Specification : 22 sheets IDS W/PTO1449 4 sheets & cited refs.

Claims : 4 sheets Declaration/Power of Attorney

Abstract : 1sheet Assignment for Recordation

Drawings : 6 sheets

Check Amt. : \$1,040.00 USD

Charge any discrepancies to Deposit Account 50-2036.

Todays Date: April 26, 2005

Attorney: DPC/fgb

JC02 Rec'd PCT/PTC 26 APR 2005

10/532833



FORM PTO-1390 REV. 2011 U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTORNEY'S DOCKET NUMBER
TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371		59216.1540 U.S. APPLICATION NO. (If known, see 37CFR1.5)
INTERNATIONAL APPLICATION NO.	INTERNATIONAL FILING DATE	PRIORITY DATE CLAIMED
PCT/IP2003/013653	(24 October 2003) 24.10.2003	(28 October 2002) 28.10.2002
TITLE OF INVENTION: AN AUTOMATIC SHIFTING-OPERATION CONTROL SYSTEM		
APPLICANT(S) FOR DO/EO/US Toshio KITAMURA; Akihisa HAYASHI; Yuichi ICHIKAWA; Isao OKAMOTO and Osamu ISOBE		
Applicant(s) herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
1. <input checked="" type="checkbox"/>	This is a FIRST submission of items concerning a filing under 35 U.S.C 371.	
2. <input type="checkbox"/>	This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371.	
3. <input checked="" type="checkbox"/>	This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.	
4. <input type="checkbox"/>	The US has been elected by the expiration of 19 months from the priority date (Article 31).	
5. <input checked="" type="checkbox"/>	A copy of the International Application as filed (35 U.S.C. 371 (c)(2)).	
	a. <input type="checkbox"/>	is attached hereto (required only if not communicated by the International Bureau)
	b. <input checked="" type="checkbox"/>	has been communicated by the International Bureau.
	c. <input type="checkbox"/>	is not required, as the application was filed with the United States Receiving Office (RO/US).
6. <input checked="" type="checkbox"/>	An English language translation of the International Application as filed (35 U.S.C. 371 (c)(2)).	
	a. <input checked="" type="checkbox"/>	is attached hereto.
	b. <input type="checkbox"/>	has been previously submitted under 35 U.S.C. 154 (d)(4).
7. <input checked="" type="checkbox"/>	Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3)).	
	a. <input type="checkbox"/>	are attached hereto (required only if not communicated by the International Bureau).
	b. <input type="checkbox"/>	have been communicated by the International Bureau.
	c. <input type="checkbox"/>	have not been made; however, the time limit for making such amendments has NOT expired.
	d. <input checked="" type="checkbox"/>	have not been made and will not be made.
8. <input type="checkbox"/>	An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).	
9. <input checked="" type="checkbox"/>	An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).	
10. <input type="checkbox"/>	An English language translation of the International Preliminary Examination Report and its annexes under PCT Article 36 (35 U.S.C. 371 (c)(5)).	
Items 11 to 20 below concern document(s) or information included:		
11. <input checked="" type="checkbox"/>	Information Disclosure Statement under 37 CFR 1.97 and 1.98	
12. <input checked="" type="checkbox"/>	An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.	
13. <input type="checkbox"/>	A FIRST preliminary amendment amending application in accordance with PCT Article 28.	
14. <input type="checkbox"/>	A SECOND or SUBSEQUENT preliminary amendment.	
15. <input type="checkbox"/>	A Substitute specification.	
16. <input type="checkbox"/>	A change of power of attorney and/or address letter.	
17. <input type="checkbox"/>	A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 35 U.S.C. 1.821-1.825.	
18. <input type="checkbox"/>	A second copy of the published international application under 35 U.S.C. 154 (d)(4).	
19. <input type="checkbox"/>	A second copy of the English language translation of the international application 35 U.S.C. 154 (d)(4).	
20. <input checked="" type="checkbox"/>	Other items or information: a. <input checked="" type="checkbox"/> Copy of International Publication No. WO 2004/038260 A1 b. <input checked="" type="checkbox"/> Copy of International Search Report issued by the Japanese Patent Office dated January 13, 2004 c. <input checked="" type="checkbox"/> Certified copies of JP Appln. Nos. 2002-312999 & 2002-313279 both filed October 28, 2002.	

U.S. APPLICATION NO. (If known, see 37CFR 1.5) <i>New Application</i>	INTERNATIONAL APPLICATION NO. PCT/JP2003/013445	ATTY'S DOCKET NO.: 59216.1520	
21. <input checked="" type="checkbox"/> The following fees are submitted:		Calculation & PTO Use Only	
Basic National Fee.....		\$300.00 \$300.00	
Examination Fee.....		\$200.00 \$200.00	
Search Fee.....		\$500.00 \$500.00	
TOTAL OF ABOVE CALCULATIONS =		\$1,000.00 \$1,000.00	
Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$250.00 for each additional 50 sheets of paper or fraction thereof.			
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	
33-100 =	/50 =	X \$250.00 \$0.00	
Surcharge of \$130.00 for furnishing the oath or declaration later than months from the earliest claimed priority date (37 CFR 1.492 (e)).		□ 20 X 30 \$0.00	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE
Total Claims	9	- 20 =	0 x \$50.00 \$0.00
Independent Claims	3	- 3 =	0 x \$200.00 \$0.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)		+ \$360.00	\$0.00
TOTAL OF THE ABOVE CALCULATIONS =		\$1,000.00	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by ½.			
		SUBTOTAL = \$1,000.00	
Processing fee of \$130.00 for furnishing the English translation later than months from the earliest priority date (37 CFR 1.492(f)).		□ 20 □ 30 \$0.00	
		TOTAL NATIONAL FEE = \$1,000.00	
Fee for recording the enclosed assignment (37 CFR 1.21 (h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property.		\$1,040.00 +	
		TOTAL FEES ENCLOSED = \$1,040.00	
		Amount to be refunded: \$ charged: \$	
a. <input checked="" type="checkbox"/>	A check in the amount of \$1,040.00 to cover the above fees is enclosed.		
b. <input type="checkbox"/>	Please charge my Deposit Account No. 50-2036 in the amount of \$ to cover the above fees. A duplicate copy of this sheet is enclosed.		
c. <input checked="" type="checkbox"/>	The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2036.		
d. <input type="checkbox"/>	Fees are to be charged to a credit card. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.		
NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137 (a) or (b)) must be filed and granted to restore the application to pending status.			
SEND ALL CORRESPONDENCE TO: (firm address)			
BAKER & HOSTETLER LLP Washington Square, Suite 1100 1050 Connecticut Avenue, N.W. Washington, D.C. 20036 DATED: <u>4/26/05</u>		SIGNATURE Dennis P. Cawley	Reg. No. 44,598